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Supreme Court of the United States

No. 277, October Term 1940.

THE AUTOMATIC DEVICES CORPORATION,
Petitioner,

vs.

SINKO TOOL & MANUFACTURING COMPANY,
Respondent.

MOTION FOR LEAVE TO FILE PETITION FOR REHEARING, PETITION AND BRIEF.

DRURY W. COOPER,
HENRY M. HUXLEY,
THOMAS J. BYRNE,
Counsel for Petitioner.

Printing Company, Inc., 80 Lafayette Street, New York, N. Y.

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This motion and accompanying petition relate solely to the Mead patent.

The District Court held claims numbered 2, 3 and 11 of the Mead patent valid and infringed (R. pp. 239, 255). The United States Circuit Court of Appeals for the Seventh Circuit, (by opinion filed April 27, 1940 (R. 502), amended June 18, 1940 (R. 563); petition for rehearing denied June 18, 1940 (R. 564)) held these claims of the Mead patent invalid and not infringed (112 F. 2d, 335).

2. Following that decision petitioner presented to this Court a petition for a writ of certiorari with brief and record. It was filed on July 24, 1940 and denied on October 14, 1940.

3. Petitioner then presented a motion to this Court to withhold notice of the denial of the petition for writ of certiorari by this Court because of the pendency of an action brought by petitioner against The Cuno Engineering Corporation in the District Court of the United States for the District of Connecticut which was then awaiting presentation in the United States Circuit Court of Appeals for the Second Circuit, and which involved the validity and infringement of the Mead patent. This petition was denied on October 21, 1940.

4. On February 3, 1941, the said suit against The Cuno Engineering Corporation was decided by the United States Court of Appeals for the Second Circuit which held that the claims of the Mead patent involved in this action (claims 2, 3 and 11) are valid and infringed (*infra*, p. 13). A petition for rehearing presented therein by defendant was denied on February 27, 1941 (*infra*, p. 18).

5. The Court of Appeals for the Seventh Circuit held the Mead patent invalid and not infringed as to claims

2, 3 and 11 and the Court of Appeals for the Second Circuit held the same claims valid and infringed by a construction substantially the same as the accused device in this suit.

6. The defendant in said suit, The Cuno Engineering Corporation, has petitioned this Court for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit. The petition was filed on March 15, 1941, No. 851 October Term, 1940, and it is predicated upon the direct conflict of determination by the Court of Appeals for the Seventh Circuit in this case and the Court of Appeals for the Second Circuit in the Cuno case as to the validity and infringement of claims 2, 3 and 11 of the Mead patent. The same issues would therefore be presented to this Court in the present case and in the *Cuno* case, if the petitions for writs of certiorari are granted in both cases by this Court.

Wherefore, since a direct conflict now exists between two Circuit Courts of Appeals with reference to the Mead patent, petitioner prays that this motion be granted by this Court, and that certiorari be granted.

The Automatic Devices Corporation

By

Drury W. Cooper,
Henry M. Huxley,
Thomas J. Byrne,
Counsel.

PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI.

To the Honorable Chief Justice and the Associate Justices of the Supreme Court:

Petitioner, The Automatic Devices Corporation, presents this its petition for rehearing of its petition for a writ of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit in the above identified case.

This case was brought for infringement of patent to Mead No. 1,736,544 and other patents. The District Court held claims 2, 3 and 11 of the Mead patent valid and infringed (R. 239, 255) and the United States Circuit Court of Appeals for the Seventh Circuit held said claims invalid and not infringed (R. 502, 563, 564).

Petitioner presented its petition to this court for a writ of certiorari on July 24, 1940. It was denied on October 14, 1940. A motion of petitioner to withhold the notice of the denial of the petition for certiorari by this Court was thereafter presented and denied on October 21, 1940.

The petition for a writ of certiorari tendered to this Court in this case concerned Mead patent No. 1,736,544 and a patent to Cohen, No. 2,140,311.

The petition with respect to Cohen patent No. 2,140,311 is withdrawn. This petition therefore concerns only the Mead patent No. 1,736,544.

This petition for rehearing is sought to be presented to this Court for the reason that, since the denial of the petition for writ of certiorari on October 14, 1940, the United States Circuit Court of Appeals for the Second Circuit determined, in an action brought by petitioner against The Cuno Engineering Corporation for infringement of the Mead patent, that claims numbered 2, 3 and 11 thereof are valid and were infringed by the defendant.

The said decision of the United States Circuit Court of Appeals for the Second Circuit was filed on February 3, 1941. A petition by defendant for a rehearing with respect thereto was presented and on February 27, 1941 it was denied.

Certified copies of the decision of the United States Circuit Court of Appeals for the Second Circuit and of its order denying petition for rehearing will be filed with this petition and printed copies thereof are included herewith (*infra*, pp. 12, 18).

The defendant in said suit, The Cuno Engineering Corporation, petitioned this Court for a writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit. It was filed on March 15, 1941, No. 851 October Term, 1940, and it is predicated upon the direct conflict of determination by the Court of Appeals for the Seventh Circuit in this case and the Court of Appeals for the Second Circuit in the Cuno case as to the validity and infringemest of claims 2, 3 and 11 of the Mead patent.

Presented herewith is an affidavit briefly describing the accused devices in this case and in the Cuno case, together with drawings showing their respective constructions (*infra*, p. 9).

It will be seen from the attached affidavit and drawings that so far as pertinent to the issue of infringement, the said devices have the same fundamental features of construction, mode of operation and results obtained.

The Questions Presented.

The petition if granted would present the following questions which we state for convenience since the petition as to the Cohen patent No. 2,140,311 is withdrawn:

1. Whether claims 2, 3 and 11 of the Mead patent No. 1,736,544 are valid.

2. Whether claims 2, 3 and 11 of the Mead patent No. 1,736,544 are infringed.

Reasons for Granting the Writ.

The discretionary power of this Court to grant the writ of certiorari is invoked upon the following ground:

That a direct conflict between Circuit Courts of Appeals has arisen and exists with respect to the validity and scope of the Mead patent as to claims 2, 7 and 11 thereof.

WHEREFORE it is respectfully submitted that petitioner's petition for writ of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit should be granted.

DRURY W. COOPER
HENRY M. HUXLEY
THOMAS J. BYRNE
Counsel for Petitioner.

BRIEF IN SUPPORT OF PETITION FOR REHEARING OF PETITION FOR WRIT OF CERTIORARI.

After the petition for writ of certiorari in this case was denied by this Court, the United States Circuit Court of Appeals for the Second Circuit rendered a decision in conflict with the decision of the Circuit Court of Appeals for the Seventh Circuit in this case as to the validity and scope of claims numbered 2, 3 and 11 of the Mead patent.

The defendant in the case referred to, which was brought by petitioner against The Cuno Engineering Corporation in the District Court of the United States for the District of Connecticut has petitioned this Court for a writ or certiorari to the United States Circuit Court of Appeals for the Second Circuit predicated upon the conflict of decisions of the Court of Appeals for the Seventh Circuit in the case at bar and of the Court of Appeals for the Second Circuit in the Cuno case as to the validity and infringement of claims 2, 3 and 11 of the Mead patent.

The petition for writ of certiorari in the Cuno case was filed with the Clerk of this Court on March 15, 1941, and was assigned No. 851 October Term, 1940.

The discretionary power of this Court is sought in order that the conflict of decisions between Circuit Courts of Appeals may be resolved. Unless this conflict of decisions is settled by this Court an anomalous situation will exist which will result not only in damage and injury to petitioner but uncertainty in the trade.

It is assumed, if the instant petition and the petition in the Cuno case are granted by this Court, that these cases may be presented one directly after the other. The issue as to validity of claims 2, 3 and 11 of the Mead patent is the same in each case. The remaining issue, as to infringe-

ment of these claims of the Mead patent, would be disposed of by the interpretation placed upon them by this Court.

The accused devices in both cases are automatic electric cigar lighters extensively used upon automobiles. As pointed out in the accompanying affidavit, both in the Sinko automatic cigar lighter and in the Cuno automatic cigar lighter an electric circuit which energizes a resistance coil forming an igniter is normally open while the igniter plug is supported in a socket in idling position. When the smoker desires to use the cigar lighter the end of the plug is pressed inwardly which results in the closing of the energizing circuit. The circuit remains closed until the igniter resistance coil reaches a predetermined temperature suitable for lighting a cigar, cigarette or pipe, whereupon thermostatic means which is heated by the heat coming from the igniter coil causes the energizing circuit to be opened and the plug to be thrust outwardly. Then the igniter plug may be removed from the socket and applied for igniting a cigar, cigarette or pipe.

Claims 2, 3 and 11 of the Mead patent read in terms and spirit upon the accused device of respondent as well as upon the accused device in the Cuno case, in which the Court of Appeals for the Second Circuit held that the claims were infringed.

Conclusion.

For the reasons recited it is urged that the petition for writ of certiorari be granted.

DRURY W. COOPER,
HENRY M. HUXLEY,
THOMAS J. BYRNE,
Counsel for Petitioner.

Affidavit.

STATE OF CONNECTICUT, }
COUNTY OF FAIRFIELD. } ss.:

ARTHUR A. JOHNSON, being duly sworn deposes and says:

I am over twenty-one years of age, a resident of Bridgeport, Connecticut and am President of Petitioner.

I am a patent attorney, a registered professional engineer for the State of Connecticut and maintain my office at Bridgeport, Connecticut.

I have been engaged in the study and development of electric cigar lighters of varying types from in the year 1924.

I was a witness for plaintiff (petitioner here) in this suit on final hearing and in the suit brought by petitioner against The Cuno Engineering Company referred to in the petition for rehearing to which this affidavit is annexed.

In each of the said cases I was called upon to explain the patents in suit, the construction and mode of operation of the accused devices and the construction of the prior art patents relied upon by the respective defendants.

In the attached drawing, Figure 1 (which is a duplicate of Fig. 3 attached to the petition for a writ of certiorari in this case) shows the Sinko device accused in this case and Fig. 2 shows the Cuno device held to infringe by the Second Circuit Court of Appeals and is a reproduction of an exhibit in that case appearing at page 341 of the record which is before this Court, I am informed, on a petition for a writ of certiorari presented by the said The Cuno Engineering Corporation.

In both devices there is a socket A which is clamped or otherwise secured to an instrument panel of an automobile.

The socket A removably holds an igniter plug B having at its inner end a resistance coil C which, when connected to a source of electric current, becomes heated to incandescence so that it may be applied to a cigar, cigarette or pipe to ignite the tobacco when the plug is bodily removed from the socket.

In both the Cuno and Sinko devices the plug B has a handle or knob D which is manually pushed in against the tension of the spring E to close the circuit when it is desired to use the device. In each of the devices there is a contact G moved by the handle D which engages and is latched by a contact member F by which the handle is held in and the circuit kept closed. In each device the contact member F is made of bimetal (thermostatic metal) and is in heat-receiving relation with the resistance coil C so that it will expand when it has received a sufficient amount of heat from the resistance coil, that is to say, when the resistance coil reaches the proper degree of incandescence for use. This expansion of the thermostatic latch F releases the handle D and its contact G so that it is automatically returned to the open circuit position by the spring E, whereupon the igniter plug may be removed from the socket and used. In each of the devices the plug comprises a sleeve portion H which remains stationary during the circuit opening and closing movements of the handle D and contact G.

In the Sinko device the bimetal contact latch F is carried by part of the plug while in the Cuno device it is carried by the socket or base. In each instance the relative movement between the circuit-closing contact G and the bimetal latch contact F is the same and the response of the latter to the heating of the resistance C is the same.

In the device disclosed in the Mead patent the relative movement between parts which results in the closing and opening of the circuit occurs between the igniter plug and

the base. In the Sinko and Cuno devices this movement occurs between the handle D and the sleeve portion H. There are therefore the same differences between the Sinko device and the Mead device as between the Cuno device and the Mead device but nevertheless in the Cuno device and in the Sinko device and in the Mead device the same results are obtained in substantially the same way and by substantially the same means.

ARTHUR A. JOHNSON

Subscribed and sworn to before me
this 21st day of March, 1941.

ANNE PISTEY,
Notary Public in and for the State of Connecticut.

(SEAL)

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 154—October Term, 1940.

(Argued January 9, 1941 Decided February 3, 1941.)

AUTOMATIC DEVICES CORPORATION,

Appellant,

—*v.*—

THE CUNO ENGINEERING CORPORATION,

Appellee.

Appeal by the plaintiff from a judgment of the District Court for the District of Connecticut, dismissing a complaint in an action to enjoin the infringement of claims two, three and eleven of Patent No. 1,736,544, issued to Herbert E. Mead on November 19, 1929; and claims one, two, ten, sixteen and eighteen of Patent No. 2,117,232, issued to Joseph H. Cohen on May 10, 1938.

Before:

L. HAND, AUGUSTUS N. HAND and CHASE,

Circuit Judges.

DRURY W. COOPER for the appellant.

ROBERT S. ALLYN for the appellee.

L. HAND, *C. J.*:

The plaintiff appeals from a judgment dismissing its complaint in an action to enjoin the infringement of two patents: i.e. claims two, three and eleven of Patent No.

1,736,544, issued to Herbert E. Mead; and claims one, two, ten, sixteen, and eighteen of No. 2,117,232, issued to Joseph H. Cohen. The district judge held that Mead's patent was not infringed, and that Cohen's patent was invalid. Both inventions are for improvements in cigar and cigarette lighters installed in motor-cars, containing a glow member heated by, or being itself, a resistance coil in an electric circuit from the igniter coil. When such lighters first appeared they were in form of plugs, carried in a socket on the dashboard and pulled out when used. Two wires from the igniter coil led to opposite ends of a resistance coil in the plug, and, when pulled taut, these closed an open contact in the circuit and heated the glow member. After the plug had been used the release of tension on the wires opened the contact, broke the circuit, and the wires were reeled back into the socket as the plug was returned. These were called "reel type" lighters; in them the plug was never out of the circuit. They were in use at least as early as 1917. In 1921 a patent was issued to one, Morris (No. 1,376,154), for another type, the "wireless" lighter, in which no wires were attached to the plug, which, when pulled out of the socket, kept hot only so long as it took the glow member to cool off. In this type, of which there were several forms, while the plug rested in the socket the contacts of the circuit were open, and when the user wished to use it he completed the circuit by pushing it home—preferably against the resistance of a spring—and he was obliged to hold it in place until the glow member was hot enough. After he concluded that it had become so (in some forms the glow member was visible) he took out the plug, used it like a match or torch, and returned it to the socket. These lighters required the continued attention of the user, because it was essential that the plug should not close the circuit while the glow member was not to be heated, and that the circuit should not be closed for too long while it was. The record does not show how

extensive was the use of these lighters before 1927 or 1928, when the plaintiff began to make them, except that they were already in great demand and much competition had developed among their manufacturers. Another device of the same sort appeared only a little more than a year after Morris (Zecchini, No. 1,437,701, Dec. 5, 1922); a third some six years later (Metzger, No. 1,622,334, March 29, 1927); and still a fourth, less than a year before Mead's patent appeared (Langos, No. 1,697,686, January 1, 1929). None of these differed basically from Morris, and they show that during the seven intervening years the art had been making rather futile attempts at improving and refining upon his disclosure.

So far as appears, nobody in this country before Mead made "wireless" lighters automatic; that is to say, so that they should hold their position, after they had been manually made to close the circuit, should automatically break the circuit when the glow member got hot enough, and should give notice that the plug was ready for use. Smith filed a British application for an automatic "cut-out" by means of a thermostat in December, 1926 (Brit. Pat. 285,200 (1928)) but that we cannot consider (§72, Title 35, U. S. C.) because the patent did not issue until 1928. Rupp had a similar device (Brit. Pat. 298,073) but even his German filing date was after Mead's. The art had indeed for many years used thermostats to break a circuit when it got overcharged; such uses go back to 1893 (Hammarstrom, No. 493,380). Moreover thermostats had been installed as "cut-outs" in tools—e.g. in sadirons—fifteen years before Mead's application was filed (Andrews, No. 1,025,852). But these uses rather fortify than impair the invention; for, the more general and familiar was the use of a thermostat to cut out an over-heated member in an electric current, the more curious it is that no one should have thought of its use to remedy the known defects of "wireless" lighters.

The only doubt, as it seems to us, that the prior art throws upon the invention arises from Copeland (No. 1,844,206) whose application was filed on April 18, 1927, four months before Mead's, and who was therefore a prior inventor. (Mead tried to carry his date back of April 18, 1927, and if it were an ordinary issue, we might agree that he succeeded, although the judge made no finding about it. Nor need we do so either; the standard in such cases is very exacting; and here no documentary evidence really corroborated the testimony of Mead and those who saw his work.) Copeland disclosed two forms of lighter, in both of which the cigar was inserted in a tube at the end of which was the glow member. In one form (figure two) the cigar was used to press the glow member against a spring and overset it, and thus to make a contact that completed the circuit; in the other form (figure six) a push-button, operable by the user's thumb, directly overset the spring. In each form after the glow member had been properly heated a thermostat pushed back the spring to its first position and broke the circuit, at the same time giving notice to the user by putting out a light. (The thermostat was not actuated by the heat of the glow member as in Mead, but by a separate resistance coil so timed as to break the circuit at the proper moment. That was, however, a difference of detail in design on which Mead's invention cannot rest.) It must be owned that Copeland's figure six did disclose a lighter, manually operated, which, once put in operation, did not require continued pressure, which automatically cut out the current when the glow member was hot enough, and which advised the user of that fact. Moreover, very few structural changes were necessary to convert this into Mead's lighter. The "tubular extension 16" (page 1, line 71), which held the glow member, was already removable; it was only necessary to make it accessible to the user and to attach the wiring to the "tubular guide, 11" (page 1, line 62). When that was done, the holder would become

a "wireless lighter" quite as much as Morris's or his successors'. This is the strength of the defendant's argument which prevailed in the Seventh Circuit (*Automatic Devices Corp.* v. *Sinko Tool & Mfg. Co.*, 112 Fed. (2) 335) and in the district court.

Nevertheless, it does not persuade us. Copeland's invention was still-born; it did not lead to the necessary modifications of Morris's lighter, nor did it suggest them; it was actually a step away from the "wireless" plug which is to be taken out, used like a match or a torch, and replaced, and which alone was capable of answering the needs of the art. Nor is it at all relevant that, after one had once thought of applying Copeland's arrangement to the plug type, the structural changes would have been simple. That is never the test; it is the conception that counts, the act of imagination which assembles the elements into the new and fruitful combination; not the working out of details. *Potts* v. *Creager*, 155 U. S. 597, 608; *Regar & Sons* v. *Scott & Williams*, 63 Fed. (2) 229, 231 (C. C. A. 2); *Patent Royalties Corp.* v. *Land O'Lakes Creameries*, 89 Fed. (2) 624, 627 (C. C. A. 2); *Kelley* v. *Coe*, 99 Fed. (2) 435, 440 (C. A. D. C.). Complicated machines, which are in the day's work for skilled mechanics, will appear magic to a tyro who may find nothing but the obvious in a combination that has failed of discovery for a decade after the need arose. It would indeed be absurd to rate this as a major invention, yet it did bring to what appears to be its final form a contrivance which had become a standard fixture in motor cars; and upon every detail of these as much human ingenuity has been expended as perhaps on any machine. Just such trifles often help sales; in the severe competition of motor car industry the perfecting of even a trifling furnishing like this may be the object of study and experiment. The art itself shows that this has been true here, as we have already seen; and the best test of what persons of routine ingenuity can do is what they have done. Per-

haps, given the same technological stage of development, the same inventions are sure to appear and at about the same time, patents or no patents; but it is certainly unwarranted to assume that the small ones need less stimulus than the great ones; rather the contrary, for minds of the first order are more apt to express themselves without other inducement than the work itself. If patents are to go to those who contribute new appliances that are beyond the limited imagination of the ordinary skilled person, this invention seems to us to merit a patent.

The claims being valid and there being nothing in the prior art which requires it, we see no reason to circumscribe them closely to the disclosure. Verbally there is no difficulty. Invention lay in the general conception reduced, of course, to practice as shown but the range of equivalents should be as broad as the actual invention, as we have often said. There is nothing which turns primarily upon the precise details of the structure; the claims are good as they read, if good at all. We hold that they are valid and infringed.

As to the Cohen patent little need be said; here Mead is prior art and anticipates all that can be regarded as more than competent designing. We agree that the claims in suit are invalid.

As to Mead's patent, judgment reversed as to claims 2, 3 and 11 (plaintiff withdrew claim 1); as to Cohen's patent, judgment affirmed.

A true copy.

D. E. Roberts
Clerk.

UNITED STATES CIRCUIT COURT OF APPEALS

Second Circuit

At a Stated Term of the United States Circuit Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the 27th day of February one thousand nine hundred and forty-one.

Present:

Hon. Learned Hand,
Hon. Augustus N. Hand,
Hon. Harrie B. Chase,
Circuit Judges.

Automatic Devices Corp.,
Plaintiff-Appellant,

v.

The Cuno Engineering Corp.,
Defendant-Appellee.

A petition for a rehearing having been filed herein by counsel for the appellee,

Upon consideration thereof, it is

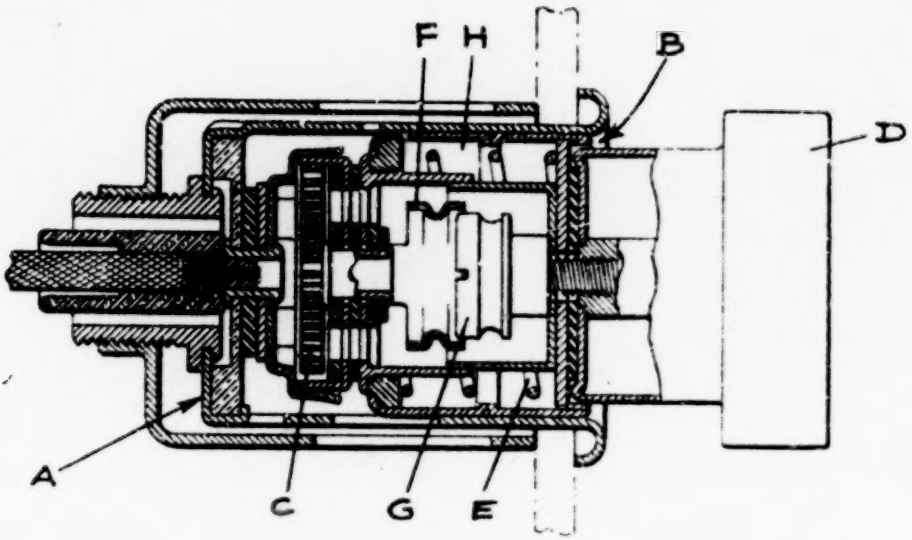
Ordered that said petition be and hereby is denied.

D. E. Roberts,
Clerk.

A true copy,

D. E. Roberts,
Clerk.

SINKO DEVICE



CUNO DEVICE